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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,160	03/29/2001	Zhongping Yu	SEL-00104.P.1-US	4265

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EXAMINER

TUNG, JOYCE

ART UNIT	PAPER NUMBER
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1637

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DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/821,160**

Applicant(s)  
**Yu et al.**

Examiner  
**Joyce Tung**

Art Unit  
**1637**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 111-169 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 111-169 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 111-150, drawn to nucleic acid molecule and its library, and the method of identifying a nucleic acid molecule, classified in class 536/435, subclass 22.1/6.

Group II, claim(s) 151-161 and 163, drawn to a second method, a method of identifying a polypeptide, classified in class 435, subclass 7.1.

Group III, claim(s) 162, drawn to a second product, a polypeptide, classified in class 530, subclass 350.

Group IV, claim(s) 164, drawn to a method of identifying a test compound, classified in class 435, subclass 7.1.

Group V, claim(s) 165-166, drawn to a third product, test compound, classified in class 536, subclass 23.1 .

Group VI, claim(s) 167, drawn to a third method, a method of identifying a target classified in class 435, subclass 6.

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Group VII, claim(s) 168-169, drawn to a forth product, target classified in class 536, subclass 23.1.

2. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I is drawn to a first product, nucleic acid sequence and the method of identifying nucleic acid sequence by using the nucleic acid sequence of claim 1. The restriction requirement of Group I is followed by the rules of PCT lack of utility in that the product claims is combined with the first method group and the product is a nucleic acid molecule which was known in the art (See the reference of Glimcher et al. (5,858,711, issued 1/12/199)). Glimcher et al. disclose an isolated nucleic acid comprising a moiety binding region and encodes an interacting domain (See the abstract) and that the nucleic acid hybridizes to a nucleic acid molecule which is considered to have the moiety binding region (See column 3, line 65-67 to column 4, lines 1-20). Thus the claims are no longer linked by a special technical feature, by definition, the special technical feature must distinguish over the prior art. Without the special technical feature the claims lack unity.

The rest of the groups follows the rules of US restriction practice as set forth below.

Group III is product claims which is drawn to a polypeptide which can be used for enzymatic reaction. Group IV is product claims drawn to a test compound. Group VII is product

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claims, drawn to a target. The products of Group IV and VII are identified by a different method which would render a different compound.

Group II is drawn to a method of identifying a polypeptide via polypeptide. Group IV is drawn to a method of identifying a test compound via determining the structure of the polypeptide. Group VI, claim(s) 167, drawn to a method of identifying a target via nucleic acid interaction. Thus, they have different operation modes. Therefore, they are different inventions.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

4. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.


Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

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5. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

J.T.  
September 12, 2003

  
**ETHAN WHISENANT**  
**PRIMARY EXAMINER**